

REMARKS

Claims 1-35 and new claim 36 are pending. By the foregoing amendment, claim 14 has been amended to clarify a first amount is administered to induce a sedated state, and new claim 36 has been added. Support for claim 36 is found in the specification, e.g., at ¶ 31, bottom of p. 12, which discloses that a conscious sedated state can be induced by administering a bolus dose of about 7.5 mg/kg (a range of about 5 mg/kg to about 10 mg/kg is also disclosed). No new matter is added.

In response to the Restriction Requirement, Applicants hereby elect, with traverse, Group IV, claims 12 and 13, for prosecution on the merits. New claim 36 also corresponds to elected Group IV.

The Office Action asserts that the claims of Groups I-XI do not form a single general inventive concept under PCT Rule 13.1 because claims of each group lack the same or corresponding technical feature, noting that the compound of Formula I itself is known. Applicants submit the Office Action has applied an improper standard for unity of invention. The unity of invention standard is discussed in M.P.E.P. § 1893.03(d):

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key.

(emphasis added). The Office Action improperly focuses on a single limitation of the claims – the compound of Formula I in isolation – without considering the claims as a whole. Under the

proper unity of invention standard, it is evident that the claims in Groups I-VII all share a common special technical feature of administering a compound of Formula I to produce an anesthetic effect (e.g., a partially anesthetized state such as conscious sedation or a more fully anesthetized state such as general anesthesia). The claims in Groups IX, X, and XI are directed to compositions containing a compound of Formula I and can be used to practice the methods claimed in Groups I-XIII. Groups IX, X, and XI therefore share a corresponding special technical feature with each of Groups I-VIII in a manner analogous to the lock-and-key example discussed above.

Applicants note that no lack of unity objection was made during the international phase (PCT/US03/10540) of the subject § 371 application. The restriction requirement thus is inconsistent with the USPTO's previous determination that claims 1-35 satisfy unity of invention (as well as all other requirements of PCT Articles 33(2)-(4)).

Reconsideration and withdrawal of the restriction requirement, and treatment of all claims 1-36 in the next Office Action, are respectfully requested. The Examiner is invited to telephone the undersigned at the number listed below if doing so would be helpful to resolve any outstanding issues.

Respectfully submitted,

BANNER & WITCOFF, LTD.

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Customer No. 22907
1100 13th Street N.W.
Suite 1200
Washington, D.C. 20005-4051
(202) 824-3000 (telephone)
(202) 824-3001 (facsimile)

By: /Paul M. Rivard/
Paul M. Rivard
Registration No. 43,446